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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,017	07/13/2001	Fred T. Parker	PA-5262-RFB	2502

7590

08/26/2004

BRINKS HOFER GILSON AND LIONE
ONE INDIANA SQUAR, SUITE 1600
INDIANAPOLIS, IN 46204

EXAMINER

MAIORINO, ROZ

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 08/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,017

Applicant(s)

PARKER ET AL.

Examiner

Roz Maiorino

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 May 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 14 and 19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 14, 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-8, 12, 14, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5700253 to Parker, and further in view of US Patent No. 5462523 to Samson.

Parker teaches a medical device with a coil in a stressed radially expanded condition, a polymeric layer positioned over and contacting at least the coil, where the polymeric layer maintaining the coil in its stressed, radially expanded condition. The coil comprises of flat wire and the polymeric layer is made from nylon with two different durometers.

However Parker does not teach a braid extending over the coil, Samson teaches a medical device with a braid extending over the coil.

Therefore, it would have been obvious to one having ordinary skill in the art the time the invention was made to have combined Parker with Samson because according to Samson the braid will provide extra support for the coil and allows for better maneuverability of the catheter tip.

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2. Claims 9-11, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.5700253 to Parker in view of U.S Patent No.5462523 to Samson et al, and further in view of U.S Patent No. 6053903 to Samson.

As mentioned above Parker and Samson ('523) teaches a medical device with a tube comprising a metal coil in a stressed radially expanded condition, a metal braid, and a polymeric layer positioned over and contacting the coil. The polymeric layer maintaining the coil in said stressed position. Furthermore, it teaches an inner lining beneath and in contact with the coil. The braid comprises of a plurality of crossed wires with a circular cross-section. And the diameter of the tube is 5-3mm.

However, Parker nor Samson teach a polymeric layer made from polyurethane or PTFE, or a heat shrinking tube with thermally bonded coil. Samson ('903) teaches a medical device with a tube comprising of a polymeric layer made from nylon or PTFE and a heat shrinking tube with thermally bonded coils. (Col.9, lines 30-35)

Therefore, it would have been obvious to one having ordinary skill in the art the time the invention was made to have combined theses studies, because according to Samson ('903) this combination of material allows for a superior critical diameter and an integrated lubricous material without adding extraneous thickness and stiffness. (Col.7, lines 60-68)

Response to Arguments

3. Applicant's arguments filed 5/6/2004 have been fully considered but they are not persuasive.

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a. Applicant alleges that the coil and braid are not combined in a manner in which the applicant has claimed. Samson does teach a braid and coil however it does not read on every one of the applicant's limitation which is why it was rejected under a 103 rejection and not a 102 rejection.

b. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as mentioned in the last office action Samson teaches combining coil and braid will provide extra support for the coil as well as a better maneuverability of the catheter tip.

c. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the purpose of the coil and braid combination as well as the problem that the combination is intended to solve) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Maiorino whose telephone number is 703-305-2336. The examiner can normally be reached on 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RM



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